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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICKY W. PURCELL and LAURA F. BRAUNECKER

Appeal 2008-4416
Application 10/648,589
Technology Center 3700

Decided: February 4, 2009

Before ERIC GRIMES, RICHARD M. LEBOVITZ, and MELANIE L.
MCCOLLUM, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection by the Examiner of claims 7-9, 11-20, 26-28, and 31. We have jurisdiction under 35 U.S.C. § 6(b). The Examiner's final rejection is affirmed-in-part.

STATEMENT OF THE CASE

The claims are directed to a flexible wrap for supporting a portion of the body. The wrap is placed around an injured body portion to support it and can hold a thermal pack (Spec. 2:28 to 3:2; 2:1-3).

Claims 7-9, 11-20, 26-28, and 31 are pending and stand finally rejected by the Examiner as follows:

1) Claims 7-9, 11, and 12 under 35 U.S.C. § 102(e) as anticipated by Chalek (US 6,936,018 B2, Aug. 30, 2005) (Ans. 4);

2) Claims 13, 26-28, and 31 under 35 U.S.C. § 102(b) as anticipated by Peterson (US 5,538,500, Jul. 23, 1996) (Ans. 5)¹;

3) Claims 15-19 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious in view of Peterson (Ans. 5 and 8);

4) Claim 14 under 35 U.S.C. § 103(a) as obvious in view of Peterson and Daneshvar (US 2003/0149389 A1, Aug. 7, 2003) (Ans. 10); and

5) Claim 20 under 35 U.S.C. § 103(a) as obvious in view of Peterson, Hymes (US 6,455,065 B1, Sep. 24, 2002), and Podell (US 5,620,702, Apr. 15, 1997) (Ans. 11).

Claims 7, 13, 15, and 26 are representative of the appealed subject matter as read as follows:

7. A flexible wrap for supporting a portion of a body, the flexible wrap comprising:
an elastic band; and
a plurality of fingers extending from an end of said elastic band, wherein said plurality of fingers are secured to an exposed section of said elastic band when the flexible wrap is

¹ The Examiner also lists claim 29 as rejected, but claim 29 is not pending.

attached to the body, wherein each of said plurality of fingers is integral with said elastic band.

13. A flexible wrap for supporting a portion of a body, the flexible wrap comprising:

an elastic band having a first end and a second end;

an adhesive layer mounted on said elastic band near said first end to secure said elastic band to a body, wherein said adhesive layer is adapted to be detachably mounted to skin on the body;

a plurality of fingers extending from said second end of said elastic band, wherein said plurality of fingers are integral with said elastic band and secured to an exposed section of said elastic band when the flexible wrap is attached to the body; and

a plurality of fasteners, wherein each finger includes at least one fastener for securing said plurality of fingers to said exposed section of said elastic band.

15. A flexible wrap for supporting a portion of a body, the flexible wrap comprising:

an elastic band;

a pack that includes a midsection; and

a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band.

26. A method of supporting a portion of a body, the method comprising:

attaching one end of an elastic band to skin on the body using an adhesive;

wrapping the elastic band around the portion of the body; and

securing a plurality of fingers that project from an opposing end of the elastic band to an exposed section of the elastic band.²

² Claim 26 is incorrect in the Claims Appendix.

PRINCIPLES OF LAW

During examination, “claims ... are to be given their broadest reasonable interpretation consistent with the specification, and ... claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990); accord *Bass*, 314 F.3d at 577 (“[T]he PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification.”); *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999) (“Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.”); *Hyatt*, 211 F.3d at 1372 Giving claims their broadest reasonable construction “serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.” *Yamamoto*, 740 F.2d at 1571; accord *Hyatt*, 211 F.3d at 1372; *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989) (“An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

In re American Academy Of Science Tech Center, 367 F.3d 1359, 1365 (Fed. Cir. 2004).

Because the hallmark of anticipation is prior invention, the prior art reference – in order to anticipate under 35 U.S.C. 102 – must not only disclose all the elements of the claim within the four corners of the document, but also must disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

NetMoneyIn, Inc. v. Verisign, Inc., 545 F.3d 1359, 1369 (Fed. Cir. 2008).

In making an obviousness determination, the following factors must be taken into consideration: (a) the scope and contents of the prior art; (b) the differences between the prior art and the claimed subject matter; (c) the

level of skill in the pertinent art; and (d) evidence of secondary considerations. *Graham v. John Deere*, 383 U.S. 1, 17 (1966).

ANTICIPATION BY CHALEK

Claims 7-9, 11, and 12 stand rejected under 35 U.S.C. § 102(e) as anticipated by Chalek (Ans. 4).

Issue

Does Chalek describe “a plurality of fingers extending from an end of” an elastic band of a “flexible body wrap” in which the fingers are “integral with said elastic band” as recited in claim 7?

Finding of Fact

The Chalek patent

1. Chalek describes a therapeutic wrap for applying a thermal pad to a human body portion (Chalek, Abstract).
2. As shown in Figure 1 reproduced below, the wrap comprises a strip 12 which “is preferably a material which is sufficiently flexible to provide a certain amount of elasticity or pliancy in the direction of elongation” (Chalek, at col. 4, ll. 46-48; Fig. 1).

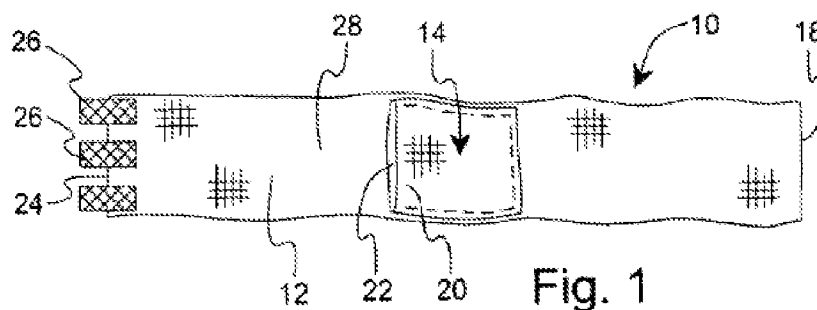


Figure 1 shows a therapeutic wrap for applying a thermal pad to a human body portion.

3. The “distal end 24 of the strip 12 includes a plurality of attachment elements 26 which are designed to attach the wrap 12 to a selected body portion of an injured individual” (Chalek, at col. 5, ll. 15-18). The attachment elements 26 are depicted in Figure 1 of Chalek as outwardly extending members or fingers.
4. “In preferred form, the attachment elements 26 are affixed to the distal end 24 and extend outwardly therefrom” (Chalek, at col. 5, ll. 18-19; Fig. 1).

Claim 7

5. Claim 7 is directed to a flexible wrap for supporting a portion of a body comprising:
6. (1) “an elastic band”; and
7. (2) “a plurality of fingers extending from an end” of the elastic band and which are “integral with said elastic band.”
8. Figure 5 of the Specification shows a plurality of fingers 34A, 34B, and 34C, extending outwardly from the end 33 of the elastic band (Spec. 7: 16-19).
9. Appellants do not dispute that the flexible strip 12 of Chalek comprises “a certain amount of elasticity” (FF2) and thus satisfies the limitation of (1) “an elastic band” as in claim 7 (FF6).
10. A plurality of attachment elements 26 are affixed to the distal end of the strip 12 (FF3, 4) as are the “fingers” recited in claim 7, meeting the recited limitation of (2) “a plurality of fingers extending from an end of said elastic band” (FF7).

11. Claim 7 also requires that the fingers are “integral” with the elastic band (FF7).

12. The Specification does not provide a definition of the term “integral.”

13. The term “integral” is defined as “an essential part of the whole” and “made up of parts that together constitute a whole.”³

14. The outwardly extending attachment elements 26 in Chalek are “affixed” to the elastic strip 12 (“elastic band” of claim 7) (FF4) becoming a part of the whole elastic strip and therefore are “integral” to it. Thus, Chalek’s elastic strip has “fingers” which are “integral” with it as required by claim 7 (*see* FF7).

Analysis

Anticipation requires that every element of the claimed invention must be found in a single prior art reference, arranged as in the claim. *NetMoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d at 1369. In this case, Chalek describes a therapeutic wrap which comprises an elastic strip 12 and attachment elements 26 which meet the limitations, respectively, of an “elastic band” and a “plurality of fingers extending from an end” of the elastic band as recited in claim 7 (FF9, 10). The fingers are affixed to and become part of the whole strip 12 after fixation and therefore are also “integral” with the strip 12 (“elastic band”) as required by claim 7 (FF14). In sum, Chalek describes all the elements of claim 7 as arranged in the claim, anticipating it.

Appellants contend “that the FIGS. of Chalek show that the attachment elements 26 are separate from the strip 12 (i.e., not ‘integral’ with the strip 12). Therefore, Chalek does not describe ‘a plurality of fingers

³ *The Random House Dictionary* 692 (Rev. Ed. 1982).

extending from an end of said elastic band . . . wherein each of said plurality of fingers is integral with said elastic band’ as recited in claim 7” (App. Br. 10).

During patent examination, the terms in a claim are given their broadest reasonable interpretation as they would be understood by persons of ordinary skill in the art in the light of the Specification. The term “integral” is sufficiently broad to read on constructions in which the fingers are “affixed” to the elastic band (FF13, 14) as they are in Chalek. The Specification does not provide a definition of “integral” nor have Appellants provided any evidence that “integral” would be understood differently or to mean “one piece” as they appear to argue it should be.

Conclusion of Law

Chalek describes “a plurality of fingers extending from an end of” an elastic band on a flexible body wrap in which the fingers are “integral with said elastic band” as recited in claim 7. Accordingly, we affirm the rejection of claim 7. Claims 8, 9, 11, and 12 fall with claim 7 as separate reasons for their patentability were not provided. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ANTICIPATION OVER PETERSON

Claims 13, 26-28, and 31 stand rejected under 35 U.S.C. § 102(b) as anticipated by Peterson (Ans. 5).

Claim 13

Issue

Does Peterson describe a flexible wrap for supporting a body portion comprising an elastic band having “an adhesive layer mounted on said

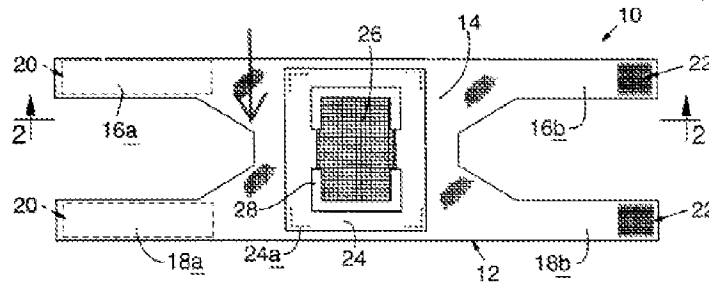
elastic band near said first end to secure said elastic band to a body” as recited in claim 13?

Findings of Fact

The Peterson patent

15. Peterson describes a resilient bandage wrap 12, preferably made of elastic material, which includes elongate strap sections 16a, 16b, 18a, and 18b (Peterson, at col. 3, ll. 13-26; *see* Figs. 1 and 3).

16. Peterson’s Figure 1, reproduced below, shows wrap 12.



Reproduced Figure 1 of Peterson shows a wrap 12. We have modified Figure 1 by adding an arrow which points to the left end of the wrap. The right end is opposite, but not marked.

17. The bandage wrap includes an absorbent pad 24 which is affixed centrally by stitching 24a or adhesive (Peterson, at col. 4, ll. 7-13).

18. The stitching is shown in Peterson’s Figure 1 as attached to the corners of the pad. Peterson states: “Furthermore, the absorptive pad need not be secured to the bandage wrap entirely about its circumference, but rather may be secured on only two sides, or in the four corners as shown in FIGS. 1 and 3” (Peterson, at col. 4, ll. 15-18). Peterson also states that, instead of stitching, the pad may be attached by permanent or temporary adhesive (*id.* at col. 4, ll. 11-15).

19. An adhesive, such as tape 28, “is applied” to the pad “along at least a portion of its perimeter, the tape being configured with an adhesive surface facing the patient’s skin so as to fix the gauze mesh in place over the patient’s wound” (Peterson, at col. 4, l. 66 to 5, l. 3).

20. Peterson’s adhesive tape 28 is shown in Figure 1 as having portions nearer to the left edge than the right edge.

Claim 13

21. Claim 13 is directed to flexible wrap for supporting a portion of a body, comprising:

22. (1) an elastic band having a first and a second end;

23. (2) “an adhesive layer mounted on said elastic band near said first end to secure said elastic band to a body”.

24. (3) a plurality of fingers extending from the second end; and

25. (4) a plurality of fasteners “wherein each finger includes at least one fastener.” The fasteners are “for securing said plurality of fingers to said exposed section of said elastic band.” The latter phrase is an intended use of the claimed fasteners and does not constitute a structure which further limits the claim scope.

26. The Specification does not define the term “near” nor what it means for the “adhesive layer” to be mounted “near” the elastic band’s first end as recited in claim 13. However, there is an embodiment is shown in the Specification where the adhesive 52 is closer to the end 53A of the elastic band than to the opposite end 53B and said to be “near” end 53A (Spec. 8: 27-31; Fig. 9).

27. The “end” of the elastic is referred to in the Specification (FF8, 26) and shown in Specification Figures 5 (*see* element 33) and 9 (*see* element 53b)

as being the distal most edge of the elastic and not to include the plurality of outwardly extending fingers.

28. Because the Specification does not define the term “near” nor provide any guidance on how “near” to the end is necessary to meet the claim limitation, we interpret it broadly consistent with the Specification to encompass locations which are closer to one end than to the other end (*see* FF26, 27).

Comparison between claim 13 and Peterson

29. Appellants do not dispute the Examiner’s findings that Peterson describes a flexible wrap comprising an elastic band, fingers extending from the second end, and fasteners on the fingers as in claim 13 (*see* claim elements as summarized in FF22, 24, and 25).

30. Peterson also describes an adhesive, such as tape, which is located closer to the left end, than the right end (FF20).

31. Since Peterson shows part of its adhesive tape to be nearer to the left end than the right end (FF20, 29), it therefore includes an adhesive mounted “near said first end”, meeting the limitation of claim 13 as we have interpreted it (FF28).

Analysis

In order to anticipate, a prior art reference must describe all the elements of the claimed invention as arranged in the claim. *NetMoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d at 1369. In this case, Appellants do not dispute that Peterson describes a flexible wrap comprising an elastic band, fingers extending from the second end, and fasteners on the fingers as in claim 13 (*see* FF29). However, Appellants contend that Peterson’s wrap

does not meet the claimed limitation of “an adhesive layer mounted on said elastic band near said first end to secure said elastic band to a body” (*see* Reply Br. 2-3).

Our mandate is to give claims their broadest reasonable interpretation as they would be understood by persons of ordinary skill in the art. As there is no definition in the Specification, we interpret “near said first end” as in claim 13 to read on a location of an adhesive which is nearer to one end of the elastic wrap than the other end (FF28) as shown in Peterson (FF31). This interpretation is consistent with certain embodiments in the Specification which show the adhesive closer to one end of the elastic wrap than the other end (FF26).

Conclusion of Law

Peterson teaches a flexible body wrap comprising an elastic band in which “an adhesive layer mounted on said elastic band near said first end to secure said elastic band to a body” as in claim 13. The rejection of claim 13 is affirmed.

Claims 26-28 and 31

Issue

Does Peterson describe a method of supporting a portion of a body comprising the step of “attaching one end of an elastic band to the skin on the body using adhesive”?

Findings of Fact

Claim 26

32. Claim 26 is drawn to a “method of supporting a portion of a body” comprising steps of attaching, wrapping, and securing an elastic band to the body portion.

33. Claim 26 specifically requires “attaching one end of an elastic band to the skin on the body using adhesive.”

Analysis

The Examiner has the burden of establishing *prima facie* anticipation. In this case, the Examiner interpreted “one end” to be “any portion or the entire portion to” one side of the band (*see* Ans. 6-7). However, this interpretation is not consistent with how the term is used in the Specification (FF8, 27). Instead, the *end* of the elastic band would correspond to the distal edge of the band – for example, as shown in Specification Fig. 5, “end 33” (FF8). Under this interpretation, there does not appear to be disclosure in Peterson in which “one end” of the elastic bandage is attached to the skin “using adhesive” as in claim 26 (FF33). Rather, Peterson states that the gauze pad comprising the adhesive tape is placed over the patient’s wound (FF19). The Examiner has not provided sufficient evidence that placing the pad over the wound would be achieved by first attaching “one end . . . using adhesive” as the term “end” has been interpreted here.

Conclusion of Law

The rejection of claim 26 and dependent claims 27, 28 and 31 is reversed because the Examiner has not adequately explained nor provided

sufficient evidence that Peterson teaches the claimed step of “attaching one end of an elastic band to the skin on the body using adhesive.”

ANTICIPATION OR OBVIOUSNESS OVER PETERSON

Claims 15-19 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Peterson (Ans. 5 and 8).

Issue

Does Peterson describe or suggest a flexible wrap for supporting a body which comprises the limitation of claim 15 of “a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band”?

Findings of Fact

34. Claim 15 is to a flexible wrap for supporting a portion of a body. The wrap comprises:

35. (1) “an elastic band”;

36. (2) “a pack that includes a midsection”; and a

37. (3) “a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band.”

38. The term “midsection” is not defined in the Specification.

39. The dictionary defines “midsection” to be “the middle section or part of anything.”⁴

40. Peterson describes an absorptive pad – i.e., a “pack” as in claim 15 – which may be fastened by stitching or adhesive, and specifically describes attachment at the pad’s circumference (FF18).

⁴ *The Random House Dictionary* 846 (Rev. Ed. 1982).

Analysis

The issue in this rejection is whether Peterson describes or suggests a pad secured to the elastic band by “a fastener extending along said midsection of said pack.” The only attachment location described in Peterson of the pad to the elastic band is around the pad’s circumference (FF18, 40). The Examiner’s interpretation of “midsection” to include the “entire section” of the pad is not reasonable because it fails to give weight to the explicit limitation in the claim that requires the fastener to be along the midsection.

The Examiner alternately rejects the claim as obvious, stating:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends along the midsection of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the manufacturing of the invention.

(Ans. 8.) The Examiner contends that if the midsection were utilized, less adhesive would be needed, and it would be less complex to apply, “because adhesive is only applied in one direction” (App. Br. 12-13).

The Examiner also states on page 6 of the Final Rejection that “it would have been an obvious matter of design choice to a person of ordinary skill in the art to place the fastener along the midsection of the pack . . . One of ordinary skill in the art would have expected Applicant's invention to perform equally well with either the fastener along the edges (as in the invention disclosed by Peterson) or the fastener along the midsection of the pack.”

Appellants contend that the Examiner's statements are conclusory (App. Br. 15). Appellants also state that positioning the adhesive layer at the midsection as claimed is advantageous because it minimizes stress on the pack as it is wrapped around the body (*id.* at 15-16).

Peterson expressly describes circumferential attachment when referring to its Figs. 1 and 3, but Peterson also teaches that adhesives may be used as fasteners (FF18) – without explicitly describing how they would be used or the location where they would be applied. Consequently, we do not read Peterson's disclosure so restrictively as to limit the attachment sites to the pad's circumference. Furthermore, in view of the lack of specific guidance as to how adhesives would be used, Peterson apparently considered these choices to be within the ordinary level of skill in the art. Thus, it is reasonable, as found by the Examiner, that fastening the pad along its midsection (or sections which comprise the midsection) would have been recognized by persons of ordinary skill in the art as suitable for securing the pad to the wrap and therefore reasonably suggested by Peterson.

With respect to Appellants' arguments as to the advantages of the claimed structure, we note that when advantages are relied upon to rebut *prima facie* obviousness, they must be compared to the closest prior art. In this case, Appellants have not stated that a comparison was performed.

For the foregoing reasons, we affirm the rejection of claims 15 and 17.

Conclusion of Law

The rejection of claims 15 and 17 as obvious over Peterson is affirmed because Peterson reasonably suggests a flexible wrap for supporting a body which comprises the claimed limitation of "a fastener extending along said

midsection of said pack such that said fastener secures said pack to said elastic band.” Claims 16, 18, and 19 fall with claims 15 and 17 because separate reasons for their patentability were not provided. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OBVIOUSNESS OVER PETERSON AND DANESHVAR

Claim 14 stands rejected under 35 U.S.C. § 103(a) as obvious in view of Peterson and Daneshvar (Ans. 10).

Claim 14 is to the flexible wrap of claim 13 in which the wrap’s elastic band includes a plurality of layers. The Examiner finds that Daneshvar teaches an elastic band with a plurality of layers and that persons of ordinary skill in the art would have been prompted to incorporate Daneshvar’s teaching into Peterson “in order to provide a stronger elastic band” (Ans. 11).

Appellants argue as they did for Peterson alone (App. Br. 16), but do not identify any deficiency in the Examiner’s reason for combining Peterson with Daneshvar. As we find none, we affirm the rejection.

Conclusion of Law

The obviousness rejection of claim 14 is affirmed.

OBVIOUSNESS OVER PETERSON, HYMES, AND PODELL

Claim 20 stands rejected under 35 U.S.C. § 103(a) as obvious in view of Peterson, Hymes, and Podell (Ans. 11).

Claim 20 depends on claim 16 which depends on claim 15. The Examiner sets forth explicit reasoning as to why claim 20 is obvious over the

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cited references (Ans. 11). Appellants do not identify any deficiency in the Examiner's reasoning, and as we find none, we affirm the rejection.

Conclusion of Law

The obviousness rejection of claim 20 is affirmed.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LP

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Application 10/648,589

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